

REMARKS

This is in response to the Final Office Action mailed September 7, 2004, in which the Examiner rejected claims 1-5 and 7-16. With this Amendment, Applicant has corrected minor grammatical errors in claims 1, 7 and 12. Reconsideration of the application is respectfully requested.

Claim Rejections - 35 U.S.C. §102

In Section 2 of the Office Action, the Examiner rejected claims 1, 7, and 8 under 35 U.S.C. §102(b) as being anticipated by Ellis (U.S. Patent No. 5,773,188). Applicant respectfully disagrees with the Examiner's assessment of Ellis and believes that the rejections can be withdrawn for the reasons set forth below.

Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Ellis is directed to a method for consolidating a contrasting pattern of intelligence borne by a backing therefor with a final receptor base element and provides illustrations of various steps of the method. However, Ellis fails to disclose any particular apparatus that could be used to implement the method. More importantly, Ellis fails to disclose or suggest the card printers described in independent claims 1, 7 and 8.

With regard to claim 1, Ellis fails to teach or even suggest a card printer that includes "a source of at least one intermediate transfer sheet . . . ; a source of at least one card;

a printhead . . . ; a sheet transport configured to move intermediate transfer sheet past the printhead; a laminator . . . ; and a separator . . . ." Additionally, Ellis fails to teach or even suggest the card printer of claim 7 that includes "a supply of individual intermediate transfer sheets . . . , a printhead . . . , a sheet transport configured to move the intermediate transfer sheet past the printhead, a laminator comprising a heated roll for receiving the sheet after printing, . . . and a device for peeling a backing film from the print receptive layer subsequent to lamination." Similarly, Ellis fails to teach or suggest the printer for cards described in independent claim 8 that includes "a printhead, a supply of individual intermediate transfer sheets, . . . a sheet drive for moving an individual intermediate transfer sheet from the supply to the printhead for printing . . . , a supply of cards, a drive for the cards and the individual intermediate transfer sheets to move the cards to a position to overlie the image receiving layer on the intermediate transfer sheet, a laminator . . . , and a separator . . . ."

Because Ellis fails to teach or suggest the card printers of claims 1, 7 and 8, the Examiner concludes that the method taught by Ellis must inherently be performed by said card printers. More particularly, the Examiner finds that Ellis must utilize a card printer that includes a source of at least one intermediate transfer sheet, a source of at least one card, "some sort of sheet drive or transportation to move the intermediate transfer sheet past the printhead in a sequential manner", "some sort of card drive in order for the apparatus to be operable", and a separator. Additionally, the Examiner finds that the laminator illustrated in FIG. 2 of Ellis is sufficiently shown as being part of a card printer that includes the inherent elements described above in order to form the card printers described in independent claims 1, 7 and 8. Applicant respectfully believes that these inherency arguments are unreasonable.

An element can only be inherent in the prior art when it is necessarily present, but not expressly described or recognized. For example, a previously unappreciated property of a prior art composition, or a scientific explanation for the prior art's functioning does not render the old composition patentably new to the discoverer. Additionally, "[i]nherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 212 USPQ 323, 326 (C.C.P.A. 1981).

Moreover, as explained in MPEP 806.05(e) a "[p]rocess and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process as *claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as *claimed* can be used to practice another and materially different process." (emphasis added)

Applicant submits that the performance of the method of Ellis is a distinct invention and must not inherently be performed by Applicant's card printer described in claims 1, 7 and 8. For example, the method of Ellis does not require "a sheet transport configured to move the intermediate transfer sheet passed the printhead" as described in claims 1 and 7, or "a sheet drive for moving an individual intermediate transfer sheet from the supply to the printhead for printing" as described in claim 8. Instead, the method of Ellis can be performed by delivering a transfer sheet from a supply to the laser ablation printhead by hand.

Additionally, the method of Ellis does not require "a separator configured to remove the backing film from the image receiving transfer layer after lamination" as described in claim 1, "a device for peeling a backing film from the print receptive layer subsequent to lamination" as described in claim 7, or "a

separator for separating the backing film from the image receiving layer laminated on the card" as described in claim 8. As above, such separating functions can be performed by hand.

Another example of how the card printer of the present invention is distinct from the method of Ellis, is that the method of Ellis does not require "a drive for the cards and the individual intermediate transfer sheets to move the cards to a position to overlies the image receiving layer on the intermediate transfer sheet" as described in claim 8. Such a device is unnecessary to perform the method of Ellis, because the final base 8 and the protective overcoating 5 can be positioned in an overlapping relationship by hand.

As a result, Applicant submits that the card printers of independent claims 1, 7 and 8 are distinct inventions that are not inherently disclosed by the method of Ellis. Accordingly, without Applicant's disclosure, the Examiner could not form the card printers of claims 1, 7 and 8 based on Ellis. Therefore, Applicant submits that independent claims 1, 7 and 8 are allowable since they are neither taught nor suggested by the prior art, and requests that the rejections be withdrawn.

#### Claim Rejections - 35 U.S.C. §103

In section 4 of the Office Action, the Examiner rejected claims 13 and 14 under 35 U.S.C. §103(a) as being unpatentable over Ellis in view of Sarraf et al. (U.S. Patent No. 5,241,328). The Examiner found Ellis to teach the steps of the method of claim 13 except for the step of "printing ink or dye on a surface of a layer on the intermediate transfer sheet . . . ." However, the Examiner found Sarraf et al. to teach a "dye transferring laser ablation step" at col. 1, lines 30-39. Applicant respectfully disagrees with the Examiner's assessment of the cited references.

In particular, Applicant has reviewed the Sarraf et al. including the passage cited by the Examiner, and is unable to locate any disclosure of using the printing method of Sarraf et al to print dye to an intermediate transfer sheet. Instead, the printing conducted by Sarraf et al. is directly to the "final receptor" in the form of a transparency, rather than to an intermediate transfer film. Moreover, nowhere in Sarraf et al. is there any suggestion that its printing method could be used to print to an intermediate transfer film for subsequent transfer to a card. Accordingly, applicant submits that the cited references fail to teach or suggest the method of claim 13, and requests that the rejection be withdrawn.

Applicant also disagrees with the Examiner's finding that Ellis teaches at Col. 4, line 59 a step of "printing reverse images on the layer", as described in claim 14. Rather, the cited passage merely mentions that the resultant image on the final receptor base 8 is a "mirror image" of the original image printed on the intermediate receptor. Therefore, the cited passage fails to disclose the features of claim 14. Accordingly, Applicant submits that claim 14 is allowable in view of the cited references, and requests that the rejection be withdrawn.

In Section 5 of the Office Action, the Examiner rejected claims 2, 3, and 12 under 35 U.S.C. §103(a) as being unpatentable over Ellis in view of Klinger (U.S. Patent No. 6,174,404 B1). Applicant respectfully disagrees with the rejections.

The Examiner found FIG. 4 of Ellis to disclose an intermediate transfer sheet that is "cut to a size providing sheet extensions from at least one side of the card" as described in claim 12, and an intermediate transfer sheet that "is larger than said card, whereby the printing extends from edge to edge of the card after the intermediate transfer sheet and the card have

been operated on by the laminator" as described in claim 12. FIG. 4 of Klinger fails to provide a view that would allow for an assessment to be made regarding the relative size of the substrate 40 to the face and back coating films 40 and 41. However, as illustrated in FIG. 5, the face and back coating films 41 and 42 are shown to be smaller than the substrate 40. More importantly, the coating films 41 and 42 are only configured to provide protection to the substrate 40 and do not include "an image receptive surface" for receiving a printed image. Accordingly, the coating films 41 and 42 are unrelated to the claimed "intermediate transfer sheets". Therefore, even assuming sufficient motivation exists to make the suggested combination, the resultant combination fails to form the inventions of claims 2 and 12. Accordingly, Applicant requests that the rejections be withdrawn.

Applicant also disagrees with the Examiner's finding that Col. 5, lines 28-30 and FIG. 2 of Klinger discloses the "plurality of intermediate transfer sheets, and a sheet feeder for feeding individual sheets to the printhead", as described in claim 3. The cited disclosure in Klinger relates to a laser printer that is configured to print directly on sheet substrates rather than intermediate transfer sheets. Thus, the stack of sheet substrates shown in FIG. 2 of Klinger are not "a plurality of intermediate transfer sheets" as described in claim 3. Additionally, the means by which Klinger feeds the sheet substrates is unrelated to the "sheet feeder" of claim 3. Accordingly, even when one assumes that the elements of independent claim 1 are sufficiently disclosed by Ellis, the combination of Ellis and Klinger does not form the invention of claim 3.

Additionally, the Examiner has failed to provide sufficient motivation for combining the cited references. The Federal Circuit has stated, "virtually all [inventions] are

combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983). The Federal Circuit has also found that rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use a claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention, which would be "an illogical and inappropriate process by which to determine patentability." Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). Accordingly, even seemingly simple changes require a finding of a suggestion in the prior art to make the modification to avoid the improper use of hindsight. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Here, Ellis fails to teach even the basic components of the card printer of the present invention. Accordingly, there can be no motivation to combine the cited sheets and sheet feeder of Klinger with Ellis, since the combination would not even form a printer, let alone the printer of claim 3. Therefore, Applicant submits that there is no suggestion or motivation to make the combination. Instead, the Examiner relies on the teachings of Applicant's disclosure to discern the "obviousness" of the claimed invention even though, at the time the Applicant made the claimed invention, those of more than ordinary skill in the relevant art had failed to perceive the card printer of claim 3. Such use of hindsight is improper. In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002) ("It is improper, in determining whether a person of ordinary skill in the art would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'") (quoting W.L. Gore v. Garlock, Inc., 220 USPQ 303, 312-13 (Fed. Cir. 1983)). Accordingly, Applicant requests that the rejection be withdrawn.

In section 6 of the Office Action, the Examiner rejected claim 15 under 35 U.S.C. §103(a) as being unpatentable over Ellis in view of Sarraf et al. as applied to claims 13 and 14, and further in view of Klinger. Applicant respectfully disagrees with the rejections.

The cited sensor of Klinger operates as a "substrate sensor" [Col. 5, line 63] and does not operate to sense "when the card and intermediate transfer sheet are in registry, prior to laminating the layer to the card", as described in claim 15. Therefore, even the combination of the cited references fails to form the card printer of claim 15. Accordingly, Applicant requests that the rejection be withdrawn.

In Section 7 of the Office Action, the Examiner rejected claims 4, 5, 10, and 11 under 35 U.S.C. §103(a) as being unpatentable over Ellis in view of Haas et al. (U.S. Patent No. 6,261,012 B1). Applicant respectfully asserts that Haas et al. is disqualified as prior art to the present application. 35 U.S.C. § 103(c) provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The present application was filed January 15, 2004 and is a Continuation of U.S. Application Serial Number 09/799,196 filed March 5, 2001. Accordingly, Haas et al. is prior art to the present application under 35 U.S.C. §102(e). Additionally, both Haas et al. and the claimed invention were assigned, or were at least under an obligation to be assigned, to Fargo Electronics, Inc., of Eden Prairie, Minnesota at the time the invention was made. As a result, Applicant asserts that Haas et al. is



disqualified as prior art to the present invention and requests that the rejections of claims 4, 5, 10 and 11 be withdrawn.

In section 8 of the Office Action, the Examiner rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over Ellis in view of Sarraf et al. as applied to claims 13 and 14, and further in view of Haas et al. Applicant requests that the rejections be withdrawn because Haas et al. is disqualified as prior art to the present invention.

In Section 9 of the Office Action, the Examiner rejected claim 9 under 35 U.S.C. §103(a) as being unpatentable over Ellis in view of Levine (U.S. Patent No. 5,647,938). Applicant respectfully disagrees with the rejection.

In particular, the cited separator 32 of Levine does not operate to engage "a portion of the intermediate transfer sheet extending from an edge of the card after lamination, for guiding the intermediate transfer sheet away from the path of the card and separating the backing film from the image receiving layer laminated on the card" as described in claim 9. Additionally, the Examiner has failed to provide any motivation for combining Levine with the method of Ellis. As explained above, Applicant does not believe that such a motivation can be established when Ellis fails to disclose a printing apparatus. Accordingly, Applicant believes that the rejection is improper, and requests that it be withdrawn.

#### Conclusion

In view of the above comments and remarks, it is believed that the present application is in condition for allowance. Consideration and favorable action is respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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